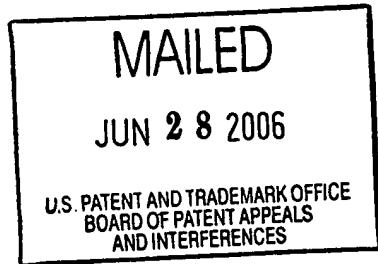


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte H. DARREL DARBY

Appeal No. 2006-1408
Application No. 10/019,669

HEARD: June 6, 2003

Before FRANKFORT, CRAWFORD and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1, 2, 4, 5, 7, 8, 10, 11, 31, 32, 41 and 42. Claims 3, 6, 9, 12-30 and 35-40 stand allowed and claims 33 and 34 stand withdrawn from consideration.

We REVERSE.

BACKGROUND

The appellant's invention relates to a healing shoe or sandal designed to aid in reducing pressure or weight from specific areas of the feet. The invention utilizes alterable insole layers of varying densities and degrees of firmness that fit into an area surrounded by a circumferential counter of the out sole in order to hold the insole layers in position. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Applied Prior Art

| | | |
|---------------------------|-----------|---------------|
| Grim et al. (Grim) | 5,329,705 | Jul. 19, 1994 |
| Darby et al. (Darby '133) | 5,370,133 | Dec. 6, 1994 |
| Darby (Darby '909) | 5,491,909 | Feb. 20, 1996 |
| Kellerman | 5,799,414 | Sep. 1, 1998 |

The Rejections

Claims 1, 2, 4, 5, 7, 8, 10, 11, 31, 41 and 42 stand rejected under 35 U.S.C. § 103 as being unpatentable over Darby '909 in view of Darby '133 and Grim and claim 32 stands rejected under 35 U.S.C. § 103 as being unpatentable over Darby '909 in view of Darby '133, Grim and Kellerman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed August 26, 2005) for the examiner's complete reasoning in support of the rejections and to the appellant's brief (filed August 3, 2005) and reply brief (filed October 26, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, for the following reasons, both of the examiner's rejections must be reversed.

Darby '909 is directed to a medical shoe designed to accommodate forefoot deformities and bulky dressings and more particularly to such shoes which are capable of being adjustably contoured for cradling the bone structure of the foot during healing (col. 1, ll. 5-10). The objective of the invention of Darby '909 is to provide a more stable and protective shoe that supports the traumatized foot and accommodates the foot when standard footwear cannot be worn due to dressing size, swelling, forefoot deformities, or the use of bulky forefoot splints or insoles (col. 1, ll. 30-35). The Darby '909 shoe includes a rocker design outer sole 16 having an insole 18 bonded to the upper surface 16A thereof by a thin layer of adhesive 20, with a metatarsal shank 22

molded integrally into the outer sole 16. The shoe also includes an upper 14 bonded to the upper surface 16A of the outer sole and includes an open toe opening 31.

As conceded by the examiner, Darby '909 lacks the out sole having a circumferential counter portion and a plurality of separably removable insole layers stacked on top of one another and being capable of being rearranged so as to be stacked in different orders, wherein the out sole circumferential counter prevents each of the plurality of insole layers from shifting within the out sole cavity when the insole layers are stacked in each of the different orders as called for in independent claims 1 and 31.

Darby '133 discloses a lower leg, ankle and foot immobilization brace having a walking sole (outer sole 22) which minimizes rocker effect; a foam insole 24 bonded to the outersole; a boot portion 18 with a heel counter 34 and a lip portion (designated 16A in Figure 1 but described as 18A in col. 5); and an upper portion 12. The lip portion of the boot forms a semi-circular vertical wall portion "providing significant protection to the exposed toes of the user" and "rises well above the upper surface of insole 24 which resides in the recess of the boot portion 18" (col. 5, ll. 5-8). Darby '133 further teaches use of a single-piece, heat molded or heat and pressure molded insole as an addition to or substitute for the foam insole 24 (col. 8, ll. 54-59).

Grim discloses footgear having orthopedic soles providing pressure relief areas for the foot. The footgear comprises a walker frame 12, including an outer sole 14 and

side struts 16. Within the frame is a soft goods type support member 20 for enclosing a lower leg, ankle and foot of the user. The support member 20 may be held in place within the frame by pads of hook and loop material on the inner surface of the struts and by straps 28 extending around the struts. The footgear is further provided with an inner sole assembly 52 mounted within the support member 20. The rear portion 58 of the inner sole assembly may extend up behind the heel of the user to cushion this area of the foot. The inner sole assembly includes a lower air bladder 64, which may contain a layer of foam material, and an upper resilient layer 66 constituting several removable sections 68 which together form a normally substantially smooth surface for engagement by the foot, the removable sections having hook and loop securing material on their lower surfaces for engagement with mating hook and loop material on the upper surface of the bladder 64.

Given the disparate functions and objectives of the three types of footwear described by Darby '909 (a shoe with a rocker design sole), Darby '133 (an immobilization brace designed for minimal rocker effect which provides uniform compression over the leg, foot and ankle area) and Grim (footgear with removable resilient elements to provide varying degrees of pressure relief for different zones of the foot), it is not readily apparent that one of ordinary skill in the art would have viewed the teachings with regard to insoles on any one of the applied shoes or braces as being applicable to either of the other types of footwear of the applied references.

In any event, as stated in In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000),

[m]ost if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant [citations omitted].

In this case, the only motivation for modifying Darby '909 by arranging the various features of the applied references to provide a circumferential counter on the outer sole of Darby '909 and a plurality of separably removable insole layers stacked on top of one another and prevented by the circumferential counter from shifting is found in the luxury of hindsight gleaned from appellant's disclosure, inasmuch as none of the references teaches or suggests providing a plurality of separably removable insole layers contained within an out sole cavity formed by a circumferential counter of the out sole of footwear so as to be prevented, when being stacked in any order upon one another, by the circumferential counter from shifting within the cavity, as called for in independent claims 1 and 31. It follows that the rejection of these claims, as well as claims 2, 4, 5, 7, 8, 10, 11, 41 and 42 depending therefrom, cannot be sustained.

The examiner's application of Kellerman provides no cure for the deficiency in the combination of Darby '909, Darby '133 and Grim discussed above. The rejection of claim 32 as being unpatentable over Darby '909, Darby '133, Grim and Kellerman thus also cannot be sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 4, 5, 7, 8, 10, 11, 31, 32, 41 and 42 under 35 U.S.C. § 103 is REVERSED.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

Muriel E. Crawford
MURRIEL E. CRAWFORD
Administrative Patent Judge

Jennifer D. Bahr
JENNIFER D. BAHR
Administrative Patent Judge

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